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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/550,348
Filing Date: April 14, 2000
Appellant(s): RANGARAJAN ET AL.

Donald R. Boys
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 1, 2008 appealing from the Office action mailed October 1, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Additionally, claims 8, 13, and 17 as being rejected under 35 U.S.C. 103(a) as being unpatentable over Light et al. (hereinafter Light, US Patent Number 6,192,380, filed March 31, 1998) in view of Burson et al. (hereinafter Burson, US Patent Number 6,405,245, US filing date of October 28, 1998) as applied to claims 1, 3, 9, 10, and 15 above, and further in view of Kraft et al. (US Patent Number 6,084,585, with US filing date of December 5, 1997).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,192,380	LIGHT ET AL.	2-2001
6,405,245	BURSON ET AL.	6-2002
5,611,048	JACOBS ET AL.	3-1997
6,084,585	KRAFT ET AL.	7-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-17 and 19 remain rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Having the user request to view summary information for the site after the registration process for that site is complete before being able to add summary information from non-solicited sites or sites the user is not registered to is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The final limitation in the independent claims states that the registration notification of the independent claims now includes, "...summarized information pertinent to the user from the site, including links to or information from alternate sites not solicited by, or registered to by the user," which is not enabled by the specification without taking steps prior to supplying this user with this information. The specification does not assert that the registration notification could include this additional information, rather the specification discloses specifically "...if a user requests summary about data on one of his sites such as, perhaps, current interest rates and re-finance costs at his mortgage site, the service may at it's own discretion provide an additional unsolicited summary from an alternate mortgage site for comparison," (page 32, lines 7-16 of appellant's specification) as a basis for when to provide unsolicited summaries. It is noted that this statement requires that the registration process for the site must have been completed and that a separate request for data must be generated to view summaries, at which point the summary data of unsolicited sites may be added

to the output document. However, the claim states that as a part of the registration process, i.e. the notification that registration has completed, is where this data is presented even though the specification is silent to this fact. Additional information on providing unsolicited summaries is provided by that appellant in the specification (page 37, line 26-page 38, line 6 of appellant's specification) however, just as earlier in the specification the summary data is not included as part of a notification of registration. The appellant must either correct the claims to enable them or specifically point out where in the specification this limitation can be properly drawn, a mere allegation that the limitations as presented are enabled will not be enough to overcome this rejection.

In an effort to correct the lack of enablement detailed above, the appellant has amended the independent claims accordingly, "...a function for navigating to the site and submitting data to a host sponsoring the site using the form associated with the site, the data including at least a request for summarized information pertinent to the user," however this new amendment also lacks enablement according to the specification. The limitation explicitly states, "...submitting data to a host sponsoring the site using the form associated with the site," this form being a registration form for registering the user to the site. At no point in the specification does the appellant provide any support for making requests for summary data via registration forms, mainly because the registration forms do not support data requests, rather they are used to allow registration to a site. The data that is submitted to the site via a form is for registration purposes only as detailed in the specification, thus it is not enabled to include a request for summarized information. The appellant must either correct the

claims to enable them or specifically point out where in the specification this limitation can be properly drawn, a mere allegation that the limitations as presented are enabled will not be enough to overcome this rejection.

Claims 1-6, 15-16, and 19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Light et al. (hereinafter Light, US Patent Number 6,192,380, filed on March 31, 1998) in view of Burson et al. (hereinafter Burson, US Patent Number 6,405,245, US filing date of October 28, 1998).

Regarding independent claim 1, Light discloses a method in which a form recognition unit detects properties about a form and a website containing a form (column 2, line 63-column 3, line 47 of Light). A matching unit then decides what data should be place in the form and at what locations, at which point the data and instructions on what to do with it (job order) is sent to the fill-in unit (column 3, line 48-column 4, line 30 of Light). The job order is an instruction that is executable by the fill-in unit and the instruction includes data necessary to navigate to and register (fill-in the form) to a site, which could include information such as an authentication password (column 3, line 30-column 4, line 30). The fill-in unit then submits the data into the form and ultimately submits the form to the host (column 3, line 48-column 4, line 30 of Light). Then, any new form information necessary for the site is added to the database containing a user's form data (column 4, lines 5-36 of Light). Light does not disclose a method in which user notification is returned to the user that includes the result of the form submission and registration attempt, including registration status, authentication

data, summary information including information from alternate sites not registered to by the user.

However, Burson discloses a method in which a user notification is returned from PI engine, which includes the results of the form submission, registration status and authentication data, and information from alternate sites not yet registered (list of all possible accessible PI) to by the user (column 6, line 66-column 7, line 17 and column 8, line 1-column 9, line 17 of Burson). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Light with the method of Burson because it would have allowed the user to track transaction results with all sites.

Regarding dependent claims 2-4, Light discloses a method in which forms are found on web pages on the Web (Internet) (column 1, lines 7-40 of Light).

Regarding dependent claim 5, Light discloses a method in which forms are filled out with information such as credit card numbers to pay for a service (Figure 6 and column 3, lines 5-59 of Light).

Regarding dependent claim 6, Light discloses a method in which the form-filling process is completely controlled by a single networked system (server) (Figure 3 and column 2, line 53-column 3, line 47 of Light).

Regarding independent claim 15, the claim incorporates substantially similar subject matter as claim 1. Thus the claim is rejected along the same rationale as claim 1.

Regarding dependent claim 16, the claim incorporates substantially similar subject matter as claims 2-4. Thus, the claim is rejected along the same rationale as claims 2-4.

Regarding independent claim 19, Light discloses a method in which a form recognition unit detects properties about a form and a website containing a form (column 2, line 63-column 3, line 47 of Light). A matching unit then decides what data should be place in the form and at what locations, at which point the data and instructions on what to do with it (job order) is sent to the fill-in unit (column 3, line 48-column 4, line 30 of Light). The job order is an instruction that is executable by the fill-in unit and the instruction includes data necessary to navigate to and register (fill-in the form) to a site, which could include information such as an authentication password (column 3, line 30-column 4, line 30). The fill-in unit then submits the data into the form and ultimately submits the form to the host (column 3, line 48-column 4, line 30 of Light). Then, any new form information necessary for the site is added to the database containing a user's form data (column 4, lines 5-36 of Light). Light discloses a method in which the system stores new form information obtained from a site once the form filling process is complete (column 4, lines 5-36 of Light). Light does not disclose a method in which user notification is returned to the user that includes the result of the form submission and registration attempt, including registration status, authentication data, summary information including information from alternate sites not registered to by the user.

However, Burson discloses a method in which a user notification is returned from PI engine, which includes the results of the form submission, registration status and authentication data, and information from alternate sites not yet registered (list of all possible accessible PI) to by the user (column 6, line 66-column 7, line 17 and column 8, line 1-column 9, line 17 of Burson). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Light with the method of Burson because it would have allowed the user to track transaction results with all sites.

Claim 7, 9-12, and 14 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Light et al. (hereinafter Light, US Patent Number 6,192,380, filed March 31, 1998) in view of Burson et al. (hereinafter Burson, US Patent Number 6,405,245, US filing date of October 28, 1998) as applied to claims 1 and 3 above, and further in view of Jacobs et al. (US Patent Number 5,611,048, issued on March 11, 1997).

Regarding dependent claim 7, neither Light nor Burson disclose a method of distributing software functions over a plurality of server nodes. However, Jacobs et al. discloses that functions to be performed on a server can be divided across multiple servers (column 4, lines 9-17 of Jacobs et al.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Light and Burson with the method of Jacobs et al. because it would have optimized the efficiency of the method of Light by splitting the workloads among multiple servers.

Regarding independent claim 9, Light discloses a method in which a form recognition unit detects properties about a form and a website containing a form (column 2, line 63-column 3, line 47 of Light). A matching unit then decides what data should be place in the form and at what locations, at which point the data and instructions on what to do with it (job order) is sent to the fill-in unit (column 3, line 48-column 4, line 30 of Light). The job order is an instruction that is executable by the fill-in unit and the instruction includes data necessary to navigate to and register (fill-in the form) to a site, which could include information such as an authentication password (column 3, line 30-column 4, line 30). The fill-in unit then submits the data into the form and ultimately submits the form to the host (column 3, line 48-column 4, line 30 of Light). Then, any new form information necessary for the site is added to the database containing a user's form data (column 4, lines 5-36 of Light). Light does not disclose a method in which user notification is returned to the user that includes the result of the form submission and registration attempt, including registration status, authentication data, summary information including information from alternate sites not registered to by the user.

However, Burson discloses a method in which a user notification is returned from PI engine, which includes the results of the form submission, registration status and authentication data, and information from alternate sites not yet registered (list of all possible accessible PI) to by the user (column 6, line 66-column 7, line 17 and column 8, line 1-column 9, line 17 of Burson). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Light

with the method of Burson because it would have allowed the user to track transaction results with all sites.

However, Jacobs et al. discloses that functions to be performed on a server can be divided across multiple servers (column 4, lines 9-17 of Jacobs et al.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Light and Burson with the method of Jacobs et al. because it would have optimized the efficiency of the method of Light by splitting the workloads among multiple servers.

Regarding dependent claims 10-12, the claims incorporate similar subject matter as claims 2-4. Thus, the claims are rejected along the same rationale as claims 2-4.

Regarding dependent claim 14, neither Light nor Burson disclose a method of distributing software functions over a plurality of server nodes, which are connected to each other via a dedicated data network. However, Jacobs et al. discloses that functions to be performed on a server can be divided across multiple servers that are connected to each other via a local area network (column 4, lines 9-17 of Jacobs et al.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Light and Burson with the method of Jacobs et al. because it would have optimized the efficiency of the method of Light by splitting the workloads among multiple servers.

Claims 8, 13, and 17 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Light et al. (hereinafter Light, US Patent Number 6,192,380, filed March 31, 1998) in view of Burson et al. (hereinafter Burson, US Patent Number 6,405,245, US filing date of October 28, 1998) as applied to claims 1, 3, 9, 10, and 15 above, and further in view of Kraft et al. (US Patent Number 6,084,585, with US filing date of December 5, 1997).

Regarding dependent claims 8, 13, and 17, neither Light nor Burson disclose a method in which the job order is written in XML. However, Kraft et al. discloses that executable instructions which can be thought of as job orders can be written in any programming language including XML (column 3, lines 35-40 of Kraft et al.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Light and Burson with the method of Kraft et al. because the use of different programming languages was interchangeable.

(10) Response to Argument

Regarding the arguments on pages 14-19, regarding the rejection of claims 1-17 and 19 under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling, the examiner contends that the rejection is still proper and thus will be maintained. The appellant argues that the limitation that states that the registration notification of the independent claims now includes, "...summarized information pertinent to the user from the site, including links to or information from alternate sites not solicited by, or registered to by the user," is enabled by the specification. However, the limitation is clearly not enabled by the specification without taking steps prior to supplying this user with this information. It is noted that this statement requires that the registration process for the site must have been completed and that a separate request for data must be generated to view summaries, at which point the summary data of unsolicited sites may be added to the output document. However, the claim states that as a part of the registration process, i.e. the notification that registration has completed, is where this data is presented even though the specification is silent to this fact. In the appellant's argument's the examiner's point is proven. The appellant argues, "In some cases, accepted values may be immediately used by the service to log-in on behalf of a user and to obtain data from the site for a user if directed to do so by XML order (p 67, lines 3-9)," however nowhere does this statement say that the registration includes unsolicited information. Rather, just as the examiner has previously pointed out, it states that "In some cases accepted values may be used..." these accepted values being the notification of a successful registration, which are then used to make a

request on behalf of a user, and as previously stated no information from unsolicited sites is provided until after this request is made. Thus, the rejection stands proper and the examiner will not withdraw the rejection. Additionally the appellant cites a portion of the specification (page 32, lines 7-16) on page 8 of the arguments, however as previously pointed out this section again supports the examiner's position and does nothing to overcome the current rejection. The specification states, "Alternatively, if a user requests a summary about data on one of his sites such as, perhaps, current interest rates and re-finance costs of his mortgage site, the service may at its own discretion provide an additional unsolicited summary from an alternate mortgage site for comparison," (emphasis added), which clearly states that a user must first make a request for summary data on one of his sites, or in other words make a request for data from a previously registered site before unsolicited data is presented. The appellant has pointed to only the second part of that sentence, starting with "the service may at its own..." in response in an attempt to take the statement out of context of the rest of the sentence, however as previously pointed out this sentence clearly supports the examiner's position and disproves the appellant's arguments in reference to the rejection.

In an effort to correct the lack of enablement detailed above, the appellant eventually amended the independent claims accordingly, "...a function for navigating to the site and submitting data to a host sponsoring the site using the form associated with the site, the data including at least a request for summarized information pertinent to the user," however this new amendment also lacks enablement according to the

specification. The limitation explicitly states, "...submitting data to a host sponsoring the site using the form associated with the site," this form being a registration form for registering the user to the site. At no point in the specification does the appellant provide any support for making requests for summary data via registration forms, mainly because the registration forms do not support data requests, rather they are used to allow registration to a site. The data that is submitted to the site via a form is for registration purposes only as detailed in the specification, thus it is not enabled to include a request for summarized information. The appellant must either correct the claims to enable them or specifically point out where in the specification this limitation can be properly drawn, a mere allegation that the limitations as presented are enabled will not be enough to overcome this rejection. The appellant has pointed to a section of the specification shown in the fourth paragraph on page 9 of the arguments, specifically the sentence, "A user presentation module 273 is provided and adapted to present any summary or refresh data to a user if it was requested before the registration," (emphasis added). However, this sentence clearly proves the examiner's point that the claimed amendments are not enabled. This sentence states that summary or refresh data is presented to the user only if it is requested, unsolicited data does not fall under the definition of "requested". Additionally the request for the data is not included in the form associated with the user nor is it presented to the site as a part of the form as stated by the claim limitation that is clearly not enabled.

Appellant additionally argue that the appellant's claims do not limit the form to a registration form as espoused by the examiner (page 16, final paragraph-page 17, first

paragraph), stating that it is not proper for the examiner to assert more limitations into the appellant's claims. However, the examiner believes that the claims very clearly denote the form to be used for registration purposes and thus disagrees with the appellant's assertion. As can be clearly seen in the claims, it is stated that "...a function for user notification of data that is the result of the form submission and registration attempt; characterized in that the instruction order contains all of the required instruction data for navigating to and registering the user to the site," (emphasis added, found in claim 1, lines 14-17 of the claims appendix attached to the brief, substantially similar limitations existing in all independent claims). These limitations clearly show that the purpose of the claims invention and the user of the form is for registering to sites that the user is not currently registered to. In addition to this, dependent claims 4 and 12 actually state that the form is "an interactive registration form", which completely contradicts the appellant's position on the claims especially due to the fact that the appellant is arguing claims 1-17 and 19 as one stand-alone entity in the submitted appeal brief.

Regarding the appellant's arguments on pages 19-21, regarding the rejection of the claim 1 under 35 U.S.C. 103(a), no actual arguments have been presented. The appellant argues based on the belief that the 112 rejection is improper that a rejection for the claims including that non-enabled limitation must be made. However, regardless of the fact that the examiner is maintaining the 112 rejection, it is important to point out that in the previous action the examiner very clearly pointed out in the rejection of the claims how the limitation that is believed to be not enabled is rejected based upon the

art. "Light does not disclose a method in which user notification is returned to the user that includes the result of the form submission and registration attempt, including registration status, authentication data, and summary information including information from alternate sites not registered to by the user. However, Burson discloses a method in which a user notification is returned from PI engine, which includes the results of the form submission, registration status and authentication data, and information from alternate sites not yet registered (list of all possible accessible PI) to by the user (column 6, line 66-column 7, line 17 and column 8, line 1-column 9, line 17 of Burson). Specifically, Burson states that when a user initially subscribes to the system, a list of list of all known information suppliers and the types of PI supplied from the provide store is shown to the user, sites the user has not registered to, but may register to in the future, this list consisting again of information suppliers (alternate sites) and the type of PI supplied (information from those alternate sites) which again the user did not solicit or register to previously (column 6, line 66-column 7, line 17 of Burson). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Light with the method of Burson because it would have allowed the user to track transaction results with all sites," (emphasis added, current and previous office action, found in the rejection of independent claim 1). Thus, the examiner has properly rejected all of the limitations of the claims as written based upon the prior art regardless of whether or not they are enabled by the specification.

Regarding the appellant's arguments in reference to claims 2-6, 15 and 16, the appellant merely states that issues are the same as claim 1, thus the same rationale found above can be applied to these claims.

Regarding the appellant's arguments in reference to claims 7, 9-12, 14, and 19, found on pages 21-26, these arguments are the same as the arguments presented for claim 1. Thus, the same rationale found above can be applied to these claims.

Regarding the appellant's arguments in reference to claims 8, 13, and 17, the appellant provides no arguments and merely states that issues are the same as claim 1, thus the same rationale found above can be applied to these claims.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Joshua D Campbell/

Examiner, Art Unit 2178

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